

### **III. Remarks**

#### **A. Claims**

Claims 1, 7, 8, 11-19, 24-27, 30-32, 34, and 38-52 are pending in the application.

Applicants have amended claims 1, 7, 8, 11-13, 16, 24-27, 30, 34, 38, 41-43, 46, 51 (incorrectly numbered), and 52 (incorrectly numbered) for purposes of clarity, and not for purposes of patentability.

Applicants have cancelled claims 14-15, 17-19, 31-32, 39, 44-45, 46 (incorrectly numbered), and 47-49 without prejudice.

Applicants have added new claims 52-54.

Applicants submit that support for the amendments and new claims exists throughout the specification and original claims. Accordingly, applicants believe that no new matter has been added. Therefore, entry of the amendments is respectfully requested.

#### **B. Rejections under 35 U.S.C. §112, 1<sup>st</sup> paragraph (enablement)**

The Office has rejected claims 1, 7, 8, 11-19, 24-27, 30-32, 34, and 38-52 under 35 U.S.C. §112, 1<sup>st</sup> paragraph, as failing to comply with the enablement requirement. *See* Office Action, page 2. Applicants submit that the Office has not established a *prima facie* case of lack of enablement. Moreover, Applicants submit that the clarifying claim amendments submitted herewith render the rejection moot.

It is well established that compliance with 35 U.S.C. §112, 1<sup>st</sup> paragraph requires the claims to be enabled so that a skilled practitioner can make and use the invention without undue experimentation. *See* MPEP §2164.01; *see also*, *In re Wands*, 858 F.2d at 737 (Fed. Cir. 1988). The Office has not indicated how a skilled artisan would have to resort to undue experimentation in order to practice the claimed invention. Instead, the Office has listed a number of questions that suggest that Applicants should provide detailed procedures for practicing the claims. *See* Office Action, pages 2-3. However, as described in MPEP §2164, "[d]etailed procedures for

making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention." Moreover, as described in MPEP §2164.01, it is well established that a "patent need not teach, and preferably omits, what is well known in the art." Applicants submit that detailed procedures are not required because one of skill in the art would be able to make and use the claimed invention without undue experimentation based upon the description and what is well known in the art.

Applicants submit that the clarifying claim amendments submitted herewith render the rejection moot. Moreover, for the reasons described herein, Applicants submit that the Office has not established a *prima facie* case of lack of enablement. Accordingly, Applicants respectfully request that the rejection be removed.

**C. Rejections under 35 U.S.C. §112, 1<sup>st</sup> paragraph (written description)**

The Office has rejected claims 30-32 under 35 U.S.C. §112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. *See* Office Action, page 3. Applicants submit that the Office has not established a *prima facie* case of lack of written description. Moreover, Applicants submit that the clarifying claim amendments submitted herewith render the rejection moot.

As described in MPEP §2163, "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." The Office asserts that the claims recite limitations (such as a field of a data structure) that would not be understood by one of skill in the art. *See* Office Action, page 3. Applicants submit that the specification, including but not limited to figures 10-11 and paragraphs [0084] and [0085], provides sufficient detail for a skilled artisan to conclude that Applicants possessed the invention described in the relevant claims. Applicants also note that data structures are generally well known and that "[i]nformation which is well known in the art need not be described in detail in the specification." MPEP §2163; *see also*, *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80 (Fed. Cir. 1986).

Applicants submit that the clarifying claim amendments submitted herewith render the rejection moot. Moreover, for the reasons described herein, Applicants submit that the Office has not established a *prima facie* case of lack of written description. Accordingly, Applicants respectfully request that the rejection be removed.

**D. Rejections under 35 U.S.C. §112, 2<sup>nd</sup> paragraph**

The Office has rejected claims 30-32 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *See* Office Action, page 3. Applicants submit that the clarifying claim amendments submitted herewith render the rejection moot. Accordingly, Applicants respectfully request that the rejection be removed.

**E. Rejections under 35 U.S.C. §101**

The Office has rejected claims 1, 7, 8, 25-27, and 38 under 35 U.S.C. §101 as being directed to non-statutory subject matter because they "are not necessarily performed by a machine and do not transform underlying subject matter." Office Action, page 4. Applicants submit that the clarifying claim amendments submitted herewith render the rejection moot. For example, the amendments clarify that the claimed methods are performed by a computer and have a meaningful limit on scope. Accordingly, Applicants respectfully request that the rejection be removed.

**F. Rejections under 35 U.S.C. §102**

The Office has rejected claims 1, 7, 8, 11-19, 24-27, 30-32, 34, and 38-52 under 35 U.S.C. §102(e) as being anticipated by Dai (US2005/0096640). *See* Office Action, page 4. Applicants submit that the rejection is improper because Dai is not prior art. Dai was filed on December 20, 2004 and claims a priority date of April 18, 2003 (US 60/463,873). In contrast, the instant application is a national stage application of PCT/US03/40302, which was filed on December 16, 2003 and claims a priority date of December 16, 2002 (US 60/433,739). Therefore, Dai is not prior art. Accordingly, Applicants respectfully request that the rejection be withdrawn.

**G. Conclusions**

Applicants have amended certain claims for purposes of clarity, and not for purposes of patentability. In light of such clarifying amendments, Applicants assert that the rejections under 35 U.S.C. §112 and 35 U.S.C. §101 are moot. Applicants also assert that the rejections under 35 U.S.C. §112 are not proper because the Office has not established a *prima facie* case of lack of enablement nor a *prima facie* case of lack of written description. Furthermore, Applicants assert that the rejection under 35 U.S.C. §102 is improper because the cited art is not prior art. In light of the aforementioned, Applicants respectfully request removal of the rejections and allowance of the claims.

It is believed that no additional fees are necessary in connection with the filing of this paper. However, if the Commissioner determines that additional fees are necessary, or if a petition is required for acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No 041133 for any such fees, and Applicants hereby make any such petition.

Date: January 5, 2011

Respectfully submitted,  
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